## REMARKS

**Rejection under 35 U.S.C. 251 -- Recapture**

Claims 14-23 stand finally rejected under 35 U.S.C. 251 as improperly recapturing subject matter surrendered in the application for the patent upon which the present reissue is based. In support of the rejection the Examiner states:

> "See *Hester Industries, Inc. V. Stein*, Inc. 142F. 3d 1472, 46 USPQ2d 1641 (Fed Cir., 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed Cir. 1997); *Ball Corp. v. United States*, 729 F. 2d 1429, 1436, 221 USPQ 289, 295 (Fed Cir. 1984). A broadening aspect in the reissue which was not present in the application for patent.
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> "The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the October 21, 2002 present reissue application.
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> "Claim 14 is of significantly broader scope than claim 1 of the surrendered patent 5,563,067. A comparison of Part (A) of claim 14 in the instant application to claim 1 of the surrendered patent shows that several structural limitation in claim 1 are not specified in claim 14. Fewer structural limitations in claim 14 constitute a broader scope over claim 1."

Applicants again agree that claims 14-23 are broader in several aspects than are the claims of the issued patent (U.S. Pat. No. 5,563,067) upon which this application is based. The only issue here is whether those broadened claims reflect an "improper" recapture of that claimed subject matter.

Again, the Patent Law provides patentees with a pathway under 35 U.S.C. § 251, to enlarge the scope of a patent's claims if the statutory framework is met, e.g., that the request for a broadening reissue be filed within two years of the issue date of that patent, fees paid, etc. Applicants have complied with all of the statutory requirements. The Office Action here only reiterates the concept that "improper recapture" is present because the rejected claims are broader than those in the patent.

Applicants reiterate that the guidelines for recapture analysis, as set forth by the Court of Appeals for the Federal Circuit, specifically require certain analyses. First, an analysis of the claims to determine whether any aspect of the reissue claims are broader than the patented claims. Further, it is incumbent upon the USPTO to demonstrate that the broader aspects of the reissue claims relate to the surrendered subject matter. To rely upon a presumption that broader claims include improperly recaptured material, the PTO must also show that the amendments were provided to overcome some statement of or stateable form of statutory rejection or regulatory objection that (if affirmed or upheld by a proper higher authority) would have been a proper basis for the USPTO to refuse issuance of a patent. The claim material excluded must be measured against that legal background. Said another way: if the amendment is voluntary and NOT the result of an attempt to amend to overcome a sustainable rejection or objection, the recapture prohibition does not attach to the claims. So, for instance, if an examiner were to call a theoretical patent applicant and suggest that a claim would be allowed if (for instance) certain obvious misspellings were to be corrected or the claim form amended to a more familiar one, and the applicant were to accept that suggestion, the applicant would be allowed to reissue the resulting patent with broader claims because there was no basis in law for the examiner's suggestion requiring the applicant to accept the suggestion. See, *In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 at 1164 (Fed. Cir. 1997).*

The burden of presenting a prima facie case of unpatentability resides with the PTO, as discussed in *In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).* In *Henster Industries, Inc. v. Stein, Inc. (1998)* the Federal Circuit held that in determining whether there is a surrender, the prosecution history of the original patent should be examined for evidence of an admission by the patent applicant regarding patentability. Furthermore, in *Clement*, the Court noted that, with regard to claim amendments, the recapture rule does not apply in the absence of evidence that the amendment was an admission that the scope of the claim was not patentable. Thus, in this instance, the PTO has the burden of producing some factual evidence tending to show that, in the original prosecution, the applicants had deliberately

surrendered the broadened aspects of the claims in the face of indication by the PTO that the claims were unpatentable. Such was not the case here.

The application of such an evidentiary burden has been re-affirmed in the late case: *In re Doyle, 293 USPQ2d 1161 (Fed. Cir. 2002).* In *Doyle*, the patent claims involved a species of catalysts; the reissue claims involved a (broader) genus of the catalysts, a genus that included the claimed species. The situation in *Doyle* was one that parallels the situation here in many respects. Claims 14-23 broadly include the material found in the claims of the '067 patent. The reissue claims in *Doyle* could have been presented in the earlier patent. The claims presented here could have been presented in the '067 patent; indeed that is the error asserted here.

In summary: applicants have presented a very normal broadening reissue. The claims here are admittedly broader than in the '067 patent. There is no evidence of applicants' acquiescing in a rejection of or objection to the claims during the prosecution of the '067 patent. There is no stated PTO rejection of the claims in the prosecution of the '067 patent nor does the Examiner's Amendment there intimate that the claims would have rejected. The factual situation here is quite similar to the situation in *In re Doyle*, a situation where the Court of Appeals for the Federal Circuit found no impermissible recapture. Consequently, the applicants respectfully request that the rejection under 35 U.S.C. 251 be withdrawn.

## CONCLUSION

The applicants believe that the case is in condition for allowance. Should the Examiner have any requests, questions, or suggestions, he is invited to contact Applicants' attorney at the number listed below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 369212000131.

Respectfully submitted,

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